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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,038	04/12/2001	Yasuhiro Nakai	1035-317	2393

23117 7590 02/04/2005

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EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,038

Applicant(s)

NAKAI ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12/7/2004 have been fully considered but they are not persuasive. The Applicant states, The Office Action admits that Morishita and Ginter fail to disclose or suggest the aforesaid underlined aspects of Claim 1. Recognizing these flaws in Morishita and Ginter, the Office Action cites Merkle. The Examiner disagrees and submits: One cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references. *In re Young*, 159 USPQ 725 (CCPA 1968). A reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969). Also, the Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Morishita discloses, a program storing section for storing a first program for controlling basic operations of said electronic apparatus so that basic operations of the apparatus are executed by controlling elements of the apparatus via the first program, and a second program that is a subroutine and is accessed in said first program so as

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to control an additional operation of said electronic apparatus so that the second program controls the additional operation that is different than the basic operations controlled by the first program, wherein the second program becomes available via elements of the apparatus that can execute the basic operations via the first program.

Col. 15, lines 50-67, Col. 16, lines 1-67, and Col. 20, lines 1-18.

The supporting reference, Ginter, is used to amplify the concept of the use of keys to release operations. Morishita teaches about the use of keys for accessing information. Col. 25, lines 37-46, and Col. 34, lines 15-19.

Morishita further teaches about wherein the second program is a subroutine of the first program. Col. 20, lines 1-5. The supporting reference, Merkle is used to amplify the wherein the second program is a subroutine of the first program.

Morishita further discloses at least eight (8) Embodiments that provide permutations of the concept of programs operating within programs and the management and control of the use of the different nested programs.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishita et al. U.S. Patent 5,968,175 [Morishita], Ginter et al. U.S. Patent 5,910,987 [Ginter], and in further view of Merkle U.S. Patent 6,330,549 [Merkle]

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3. As per claims 1 and 5:

4. Morishita discloses:

a program storing section for storing a first program for controlling basic operations of said electronic apparatus so that basic operations of the apparatus are executed by controlling elements of the apparatus via the first program, and a second program that is a subroutine and is accessed in said first program so as to control an additional operation of said electronic apparatus so that the second program controls the additional operation that is different than the basic operations controlled by the first program, wherein the second program becomes available via elements of the apparatus that can execute the basic operations via the first program. Col. 15, lines 50-67, Col. 16, lines 1-67, Col. 20, lines 1-18, and Fig. 14.

a control section for implementing a desired operation by executing only said first program, or both said first and second programs; Col. 4, lines 25-37.

a system managing section that, that renders the additional operation implementable, makes said second program accessible in said first program. Col. 7, lines 5-20.

Morishita discloses the claimed invention except for the system managing section that, response to a releasing key operation. However Morishita teaches about the use of keys for accessing information. Col. 25, lines 37-46, and Col. 34, lines 15-19. Ginter teaches that it is known in the art to provide a releasing key operation. Col. 46-47, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the software use method control system of

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Morishita with the releasing key operation of Ginter, in order to provide the control and security required to insure proper protocol is followed to receive the remuneration assigned to the use of the software program.

Morishita discloses the claimed invention, as discussed above, except for the step of wherein said first program is accessible and operable both before and after the releasing key operation. However, the Examiner submits that both the main programs in the Application and the Prior Art remain functional because neither of them teaches about the changes in the original operating program that would affect their accessibility or operability after the releasing operation. In fact, the Examiner submits that the original operating programs of the Application and the Prior Art by definition must maintain their operability because the purpose of the release key operation is to expand/complement the original operating program.

Since the applicant has not disclosed that wherein said first program is accessible and operable both before and after the releasing key operation solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Morishita will perform the invention as claimed by the applicant with any means, method, or product to wherein said first program is accessible and operable both before and after the releasing key operation.

1. In reference to Claim 5, wherein said releasing key operation determines whether the release key information matches release key information stored in memory and if so

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then making the second program accessible. The Examiner submits that the normal procedure for a release key operation, as shown in the prior art, is a comparison with an internal key within a program, to an externally acquired key from the person desiring to control the use of the program.

In reference to, wherein the second program is a subroutine of the first program. It is well known that a person having ordinary skill in the art that the concept of shareware, i.e. providing a demo or short version of a program for non-restricted use, requires a key to access the rest of the program. Morishita teaches about the copyright owner creating protected software, which can be used by his specified use method. Col. 19, lines 50-54. Morishita further teaches encoding a key with the personal ID of the owner, the software ID and the user's personal ID. Col. 25, lines 37-50.

Merkle teaches that it is known in the art to provide wherein the second program is a subroutine of the first program. Col. 3, lines 28-50. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the software use control system of Morishita with the wherein the second program is a subroutine of the first program of Merkle, in order to promote the use of the program by providing a demo or short version of a program for non-restricted use.

As per claims 2, 6, 10, and 16:

Morishita further disclose:

wherein said releasing key is produced using at least information peculiar to said apparatus. Col. 69, lines 30-40.

As per claims 3, 7, 11, and 17:

Morishita further discloses:

said electronic apparatus is connected with a managing side via a wide-area network; and the managing side carries out the releasing key operation by remote control. Fig. 8.

As per claims 4, 8, 14, and 20:

Morishita further discloses:

said program storing section stores a plurality of second programs; and with respect to a certain combination of said second programs, said system managing section renders said second programs implementable by only one releasing-key operation. Col. 14, lines 12-67

As per claims 9 and 15:

Morishita discloses:

a program storing section for storing a first program for controlling basic operations of said electronic apparatus so that basic operations of the apparatus are executed by controlling elements of the apparatus via the first program, and a second program that is a subroutine and is accessed in said first program so as to control an additional operation of said electronic apparatus so that the second program controls the additional operation that is different than the basic operations controlled by the first

program, wherein the second program becomes available via elements of the apparatus that can execute the basic operations via the first program. Col. 15, lines 50-67, Col. 16, lines 1-67, Col. 20, lines 1-18, and Fig. 14.

a control section for implementing a desired operation by executing only said first program, or both said first and second programs; Col. 4, lines 25-37 and Fig. 9

Morishita discloses the claimed invention except for the a system managing section that, in response to a releasing key operation, makes said second program accessible by said first program, and said management system comprising a key issuing section on a managing side, said key issuing section issuing said releasing key upon confirming that a predetermined procedure has been conducted by a user side. However, Morishita teaches about the use of keys for accessing information. Col. 25, lines 37-46, and Col. 34, lines 15-19.

Ginter teaches that it is known in the art to provide a system managing section that, in response to a releasing key operation, makes said second program accessible by said first program, said management system comprising a key issuing section on a managing side, said key issuing section issuing said releasing key upon confirming that a predetermined procedure has been conducted by a user side. Col. 53-56, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the software use method control system of Morishita with the system managing section that, in response to a releasing key operation, makes said second program accessible by said first program, said management system comprising a key issuing section on a managing side, said key issuing section issuing said

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releasing key upon confirming that a predetermined procedure has been conducted by a user side of Ginter, in order to provide the control and security required to insure proper protocol is followed to use the software program.

Morishita discloses the claimed invention, as discussed above, except for disclosing wherein said first program is accessible and operable both before and after the releasing key operation. However, the Examiner submits that both the main programs in the Application and the Prior Art remain functional because neither of them teaches about the changes in the original operating program that would affect their accessibility or operability after the releasing operation. In fact, the Examiner submits that the original operating programs of the Application and the Prior Art by definition must maintain their operability because the purpose of the release key operation is to expand/complement the original operating program.

In reference to, wherein the second program is a subroutine of the first program. It is well known that a person having ordinary skill in the art that the concept of shareware, i.e. providing a demo or short version of a program for non-restricted use, requires a key to access the rest of the program. Morishita teaches about the copyright owner creating protected software, which can be used by his specified use method. Col. 19, lines 50-54. Morishita further teaches encoding a key with the personal ID of the owner, the software ID and the user's personal ID. Col. 25, lines 37-50.

Merkle teaches that it is known in the art to provide wherein the second program is a subroutine of the first program. Col. 3, lines 28-50. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the

software use control system of Morishita with the wherein the second program is a subroutine of the first program of Merkle, in order to promote the use of the program by providing a demo or short version of a program for non-restricted use.

As per claims 12 and 18:

Morishita further discloses:

wherein, on said managing side, said key issuing section issues said releasing key in response to entrance into a use contract or payment of a use fee. Col. 32, lines 1-37.

As per claims 13 and 19:

Morishita further discloses:

wherein history information relating to say said managing side manages issuance of a releasing key. Col. 33, lines 1-45.

As per claim 21:

Morishita further discloses:

wherein said releasing key operation comprises, in response to a request by the electronic apparatus, the electronic apparatus receiving release key information from a service center remote from the electronic apparatus and determining whether the release key information matches release key information stored in memory and if so then making the second program accessible. Col. 7, lines 5-25.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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2/1/2005

Daniel L. Greene
Examiner
Art Unit 3621